

REMARKS

Response to Notice of Non-Compliant Amendment

In the Notice of Non-Compliant Amendment mailed October 8, 2008, the Examiner indicates that claims 19 and 20 have markings remaining from previous amendments. Applicants have removed the markings in this response. Applicants submit that this response places the application in condition for allowance and request that any subsequent non-compliant aspects found by the Examiner be addressed through an Examiner's amendment to reduce cycle time as permitted by MPEP 714 II. E.

Below are remarks responsive to the Restriction Requirement mailed March 21, 2008.

Response to Restriction Requirement

Claims 1-34 and 36-39 were presented for examination and were pending in this application. In the latest Office Action, claims 1-34 and 36-39 were subject to a restriction requirement under 35 U.S.C. § 121.

Response to Restriction Requirement

In making the restriction requirement, the examiner identified two inventions:

- Group I, including claims 1, 4-18, 21-34, 38 and 39, drawn to storing a searchable index to a storage medium.
- Group II, including claims 2, 3, 19, 20, 36 and 37, drawn to receiving a search query to locate a media file and outputting results.

In response to this restriction requirement, Applicants elect *with traverse* to prosecute Group II in this application, which includes claims 2, 3, 19, 20, 36 and 37.

Applicants traverse the restriction requirement on the ground that there has been no *prima facie* showing that restriction is proper. The Examiner indicates that restriction is proper

because the inventions of Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP 802.01 and 806.06). Specifically, the Examiner states that Group II requires a method of processing a query to locate relevant media files while Group I is directed to how to store an index on a storage medium.

However, the claims of Group I and Group II are clearly related and capable of use together. Each group recites similar claim elements directed to monitoring an application, capturing an event, indexing event data, and storing. These claim elements are not identically recited, and Group II includes additional process steps not found in Group I. However, these differences do not justify a finding that the inventions are unrelated or incapable of use together.

The Examiner further indicates that restriction is proper because there would be a serious search and examination burden if restriction were not required (See MPEP 803). However, the claim elements of the different Groups identified by the Examiner are sufficiently related so that a search and examination of the claim elements from one Group necessarily involves a search and examination of most claim elements of the other Group. Furthermore, the Examiner has already searched claims substantially similar to those currently presented. The Examiner has not provided any explanation as to why there would now be a serious search and examination burden beyond the search already conducted.

The improper nature of the restriction requirement is apparent when the claims are analyzed under the combination/sub-combination distinctions described by MPEP 806.05(c). Group I, independently claimed in claim 1, recites the steps of:

- (A) monitoring...,
- (B) capturing...,
- (C) indexing..., and

(D) storing....

Group II, independently claimed in claim 36, recites the steps of:

(A) monitoring...,

(B) capturing....,

(C and D) indexing and storing...,

(E) receiving...,

(F) locating..., and

(G) outputting....

It is noted that the claim elements that are analogous among the Groups (represented by the letters A, B, C, and D) are not identical as independently claimed; therefore, these claim elements do not necessarily have an identical scope. However, the claim elements are sufficiently analogous for the purpose of analyzing the appropriateness of a restriction requirement. Thus, Group I (A,B,C,D) should be properly treated as a subcombination of the combination found in Group II (A,B,C,D,E,F,G).

Under MPEP 806.05(c), to support a requirement for restriction between a combination and a subcombination, the Examiner must show that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, *and* (2) the subcombination can be shown to have utility either by itself or in other and different relations. The Examiner did not recognize the combination/subcombination relationship between the groups and did not meet the burden of supporting the restriction by the two part test required under MPEP 806.05(c).

Even if the test outlined in MPEP 806.05(c) were applied, the restriction requirement would be improper. MPEP 806.05(c) provides examples of proper and improper restriction requirements. In the examples, the MPEP represents a combination as AB (e.g., Group II) and a subcombination as B (e.g., Group I), and it further represents the subcombination as B_{ex} if

broadly recited or B_{sp} if recited with relatively more specific characteristics. As MPEP 806.05(c) explains, a restriction requirement would be proper where the combination and subcombination are related as AB_{br}/B_{sp}, i.e., where the subcombination recites B with more specific characteristics than the combination does. The MPEP also explains that a restriction requirement would be improper if the combination and subcombination were related as AB_{sp}/B_{sp}, i.e., where the common subcombination portion of the combination is not broadly defined compared to the subcombination alone. The present case is like the latter example. The subcombination part of the combination (Groups II) is not broadly recited relative to the subcombination (Group I), and the specific characteristics set forth in the subcombination (Group I) are not omitted in the combination (Groups II). Rather, the combination (Group II) actually includes elements recited more narrowly than the subcombination (Group I). Therefore, the present case is more akin to the AB_{sp}/B_{sp} example, for which the MPEP indicates a restriction requirement would be improper.

Amendments to the Claims

Applicants have canceled claims 4-17 and 21-34 originally associated with Group I. Applicants have further added new claims 40-67. New claims 40-53 depend directly or indirectly from claims 36 of Group II and new claims 54-67 depend directly or indirectly from claim 37 of Group II. Accordingly, the new claims 40-67 should fall within elected Group II and should therefore be examined in the present application.

Furthermore, Applicants note that claim 36 has been allowed in the Office Action of September 26, 2007. Claim 37 and dependent claims 2-3, 19-20, and 40-67 are patentable for at least the same reasons as claim 36. Therefore, all elected claims should now be in condition for allowance.

For the above reasons, Applicants respectfully request that the Examiner reconsider the restriction requirement and enter the amendment. The Examiner is invited to contact the undersigned by telephone to advance the prosecution of this application.

Respectfully Submitted,
DAVID B. AUERBACH, ET AL.

Date: October 17, 2008

By: /Brian Hoffman/
Brian M. Hoffman, Reg. No. 39,713
Attorney for Applicants
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel.: (415) 875-2484
Fax: (415) 281-1350